

Docket No.: 1293.1050

#13
smc
5/16/02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES



Re the Application of:

Ki-young KIM, et al.

Serial No. 09/179,405

Group Art Unit: 2642

Confirmation No.

Filed: October 27, 1998

Examiner: W. DEANE, JR.

For: TELEPHONE NUMBER SEARCHING SYSTEM SUPPORTING AUTOMATIC
TELEPHONE CONNECTION AND METHOD THEREFOR

RECEIVED

MAY 15 2002

Technology Center 2600

APPELLANT'S BRIEF UNDER 37 C.F.R. §§ 1.191 AND 1.192

Assistant Commissioner
for Patents
Washington, D.C. 20231

Pursuant to the Appellants' earlier filed Notice of Appeal on March 11, 2002, Appellants hereby appeal to the Board of Patent Appeals and Interferences from the final rejection mailed October 10, 2001.

Appellants submit this Appeal Brief in triplicate as required by 37 C.F.R. §1.192(a) along with the filing fee of \$320.00 set forth in 37 C.F.R. §1.117(c).

I. Real Party in Interest

The inventors, Ki-young Kim, Min-seop Lee and Hwa-kyung Lee, assigned all rights in the subject application to Samsung Electronics Co. Ltd., on October 27, 1998, according to the Assignment recorded at Reel 9551, Frame 0342, thus the real party in interest is:

Samsung Electronics Co., Ltd.
416, Maetan-dong, Paldal-gu,
Suwon-city, Kyungki-do
Republic of Korea

05/14/2002 JADD01 00000012 09179405

01 FC:119

320.00 0P

II. Related Appeals and Interferences

Pursuant to 37 C.F.R. §1.192(c)(2), although the real party in interest has other appeals and interferences, none of the other pending appeals and interferences is believed to directly

affect or be directly affected by, or have any bearing upon the decision of the Board of Patent Appeals and Interferences in this appeal.

III. Status of Claims

Claims 1-16, 18 and 19 are pending in the application. All of claims 1-16, 18 and 19 stand rejected under 35 U.S.C. §103(a).

IV. Status of Amendments

According to the Office Action mailed October 10, 2001, the Amendment filed on July 24, 2001 was apparently entered and no Amendments have been submitted since July 24, 2001. A Response to the Final Rejection of October 10, 200 was filed on March 1, 2001, however, no claim amendments were included.

V. Summary of the Invention

The present invention relates to a telephone number searching system. Telephone numbers are stored in a telephone number data base and a web server is connected to the telephone number data base. An information terminal having a web browser selectively connects to the web server, submits a search request for searching the telephone number database, obtains one or more telephone numbers from the data base in accordance with the search request and displays the one or more telephone numbers to a user. A telephone plug-in is connected with the information terminal and automatically dials a telephone number selected by a user from the displayed telephone numbers to set up a communication channel through the telephone, independent of the web server and the information terminal.

In an embodiment of the invention, telephone numbers are stored in a telephone directory data base (FIG. 2, 220, page 4, line 9) and a web server (FIG. 2, 210, page 4, line 9 and page 5, lines 5-20) is connected to the telephone directory data base. An information terminal having a web browser (FIG. 2, 200, page 5, lines 5-10) selectively connects to the web server (page 5, lines 5-10), submits a search request (page 5, lines 19-24) for searching the telephone number database, obtains one or more telephone numbers from the data base in accordance with the search request (FIG. 5) and displays the one or more telephone numbers to a user. A telephone plug-in (FIG. 2, 230, page 6, lines 3-13) is connected with the information terminal and automatically dials a telephone number (page 6, lines 14-22) selected by a user from the displayed telephone numbers to set up a communication channel through

the telephone, independent of the web server and the information terminal (page 6, lines 14-22).

VI. Concise Statement of Issues Presented for Review

At page 2 of the Office Action, claims 1-16, 18 and 19 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 6,091,808 to Wood et al. in view of U.S. Patent 5,764,736 to Shachar et al.

At issue is whether the prior art teaches or suggests the limitations recited in the claims and whether the prior art teaches or suggests combining references in the manner proposed by the Examiner so that the invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made.

VII. Grouping of Claims

The following claims stand or fall together: (A) claims 1-7; (B) 8-13; and (C) 14-16 and 18, 19.

VIII. Argument

Group (A)

Claim 1 recites "a telephone plug-in, connected with said phone and said information terminal, to automatically dial one telephone number to set up a communication channel through said telephone independent of said web server and said information terminal."

The Examiner admits that Wood et al. does not teach "a telephone plug-in having the ability to set up a communication channel through the telephone independent of the web server and asserts that Shachar et al. teaches such a feature. Further, the Examiner asserts that it would have been obvious to one of ordinary skill in the art [at the time the invention was made] to have provided the Wood et al. device with such an ability to set up a communication channel through the telephone independent of the web server as taught by Shachar et al. as such would only entail the substitution of one known plug-in for another. In this regard, the Examiner's conclusion appears unsupported since the Wood et al. device has no telephone plug-in "connected with the information terminal" as claimed in claim 1. Thus, there is no telephone plug-in in Wood et al. for which another telephone plug-in could be substituted. The addition of "a telephone plug-in, connected with said phone and said information terminal, to automatically dial one telephone number to set up a communication channel through said telephone

independent of said web server and said information terminal in the manner" as claimed in claim 1 to the Wood et al. device would be impermissible hindsight reconstruction of Applicants' invention.

The Examiner has the burden under 35 U.S.C. §103 to establish a prima facie case of obviousness. See *In re Piasecki*, 223 USPQ 785, 787-87 (Fed. Cir. 1984). This burden can only be satisfied by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. *In re Fine*, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988).

The Examiner is picking various elements which are found in the prior art and using the Applicants' disclosure as a template or blueprint for reassembling the elements and then concluding that the combination claimed by the Applicants in claim 1 is taught in the prior art. This procedure amounts to impermissible hindsight. Hindsight cannot be used in determining the issue of obviousness and the reviewer must view the prior art without reading into that art the teachings of the application. See *Kalman v. Kimberly Clark Corp.*, 713 F.2d 760, 218 U.S.P.Q. 781 (Fed.Cir.1983). Combining prior art references without evidence of a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight. *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

The prior art must not only suggest the desirability that the teachings of references be combined but must also suggest the desirability of the modifications in the manner proposed by the Examiner as well as the results to be achieved. *Ex parte Costa*, 211 U.S.P.Q. 636 (P.O.Bd.App.1978), *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 221 U.S.P.Q. 929 (Fed.Cir.1984), *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed.Cir.1984), *Lear Siegler v. Aeroquip Corp.*, 733 F.2d 881, 221 U.S.P.Q. 1025 (Fed.Cir.1984) and *Diversitech v. Century Steps*, 850 F.2d 675, 7 U.S.P.Q.2d 1315 (Fed.Cir.1988).

It is respectfully submitted that the Examiner has not met his burden of demonstrating obviousness within the meaning of 35 U.S.C. §103(a).

Claims 2-7 stand or fall with claim 1.

Group (B)

Claim 8 recites a telephone number searching method supporting automatic comprising the steps of: (a) connecting a web browser to a web server; (b) inputting a search term to be searched to the web server; (c) searching a telephone number database in which a plurality of

telephone numbers are associated with corresponding search terms with the web server using the input search term, and displaying at least one telephone number which corresponds to the input search term; and (d) selecting one telephone number from the at least one telephone number displayed in said step (c) and operating a telephone plug-in to dial the selected one telephone number automatically and independently of said web server. Claim 8 is deemed to be patentable at least for reasons set forth above regarding claim 1.

Claims 9-13 stand or fall with claim 8.

Group (C)

Claim 14 recites a telephone number searching method, comprising the steps of: (a) connecting a web browser to a web server which is connected to a telephone database having search terms and corresponding telephone numbers; (b) entering at least one search term by a user to the web browser; (c) searching the telephone database for the at least one search term, and displaying at least one telephone number corresponding to the at least one search term; and (d) selecting one of the at least one telephone number by the user, and automatically dialing the selected one telephone number independently of said web server if the selected one telephone number is defined by a link syntax for executing the automatic dialing. Claim 14 is deemed to be patentable at least for similar reasons set forth above regarding claim 1.

Claims 15, 16, 18 and 19 stand or fall with claim 14.

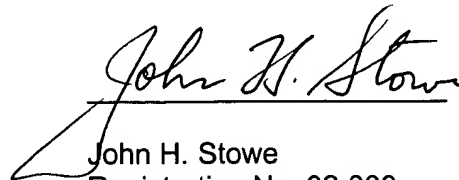
IX Summary

For the forgoing reasons, Appellant submits that the Examiner's rejection of claims 1-16, 18 and 19 is erroneous, and reversal of his decision is respectfully requested.

The required fee of \$320.00 is attached. If any further fees are required, please charge same to deposit account no. 19-3935.

Respectfully submitted,

STAAS & HALSEY


John H. Stowe
Registration No. 32,863

Dated: 5/13/02
700 Eleventh Street, N.W.
Suite 500
Washington, D.C. 20001
(202) 434-1500

X Appealed Claims

1. A telephone number searching system comprising:
a phone;
a telephone number database to store multiple predetermined telephone numbers;
a web server connected to said telephone number database;
an information terminal having a web browser, selectively connected to said web server,
to submit a search request for searching the predetermined telephone numbers in said
telephone number database through said web server, to obtain a telephone number service
comprising at least one searched for telephone number among the predetermined telephone
numbers in accordance with the search request and to display the at least one searched for
telephone number; and

a telephone plug-in, connected with said phone and said information terminal, to
automatically dial one telephone number selected by a user among the at least one displayed
telephone number to set up a communication channel through said phone independent of said
web server and said information terminal.

2. The telephone number searching system as claimed in claim 1, further
comprising a personal computer which includes the information terminal having the web
browser, wherein the phone is a telephone.

3. The telephone number searching system as claimed in claim 1, further
comprising a web phone which includes the information terminal having the web browser and
the phone.

4. The telephone number searching system as claimed in claim 1, further
comprising a hand-held phone which includes the information terminal having the web browser
and the phone.

5. The telephone number searching system as claimed in claim 1, wherein the
information terminal having the web browser connects to said web server to submit the search
using a telephone line, and stops the connection in response to the telephone plug-in
automatically dialing the one telephone number, and said telephone plug-in automatically dials
the one telephone number using the telephone line.

6. The telephone number searching system as claimed in claim 5, wherein the information terminal having the web browser reestablishes the connection to said web server using the telephone line subsequent to the automatic dialing of said telephone plug-in, to enable the user to select another one of the at least one displayed telephone number.

7. The telephone number searching system as claimed in claim 1, wherein the information terminal having the web browser connects to said web server to submit the search using a first telephone line, and said telephone plug-in automatically dials the one telephone number using a second telephone line.

8. A telephone number searching method supporting automatic dialing comprising the steps of:

- (a) connecting a web browser to a web server;
- (b) inputting a search term to be searched to the web server;
- (c) searching a telephone number database in which a plurality of telephone numbers are associated with corresponding search terms with the web server using the input search term, and displaying at least one telephone number which corresponds to the input search term; and
- (d) selecting one telephone number from the at least one telephone number displayed in said step (c) and operating a telephone plug-in to dial the selected one telephone number automatically and independently of said web server.

9. The method as claimed in claim 8, said step (d) comprises the step of operating the telephone plug-in to dial the selected one telephone number automatically if the selected one telephone number is described by a predetermined tag.

10. The method as claimed in claim 9, wherein the predetermined tag is defined as "<dialto> telephone number </dialto>".

11. The telephone number searching system as claimed in claim 8, wherein said step (c) comprises the steps of:

transferring each of the plurality of telephone numbers and the corresponding search terms by the web server to the web browser as a hypertext markup language (HTML) document;

displaying the HTML document.

12. The method as claimed in claim 8, wherein:

said step (a) comprises connecting the web browser to the web server using a telephone line; and

said step (d) comprises the step of disconnecting the web browser from the web server over the telephone line prior to operating the telephone plug-in to dial the selected one telephone number automatically over the telephone line.

13. The method as claimed in claim 8, wherein:

said step (a) comprises connecting the web browser to the web server using a first telephone line; and

said step (d) comprises operating the telephone plug-in to dial the selected one telephone number automatically over a second telephone line.

14. A telephone number searching method, comprising the steps of:

(a) connecting a web browser to a web server which is connected to a telephone database having search terms and corresponding telephone numbers;

(b) entering at least one search term by a user to the web browser;

(c) searching the telephone database for the at least one search term, and displaying at least one telephone number corresponding to the at least one search term; and

(d) selecting one of the at least one telephone number by the user, and automatically dialing the selected one telephone number independently of said web server if the selected one telephone number is defined by a link syntax for executing the automatic dialing.

15. The telephone number searching method as claimed in claim 14, wherein said step (d) comprises the steps of:

determining whether the selected one telephone number is defined by the link syntax for executing the automatic dialing; and

operating a telephone plug-in to execute the automatic dialing if the selected one telephone number is defined by the link syntax.

16. The method as claimed in claim 14, wherein:

said step (a) comprises the step of connecting the web browser to the web server using a telephone line; and

said step (d) comprises disconnecting the web browser from the web server over the telephone line, and operating the telephone plug-in to dial the selected one telephone number automatically over the telephone line.

18. The method as claimed in claim 16, further comprising the step (e) of reestablishing the connection between the web browser and the web server subsequent to the automatic dialing of the selected one telephone number, to enable the user to select another one of the telephone numbers corresponding to the at least one search term.

19. The method as claimed in claim 14, wherein:

said step (a) comprises connecting the web browser to the web server using a first telephone line; and

said step (d) comprises operating the telephone plug-in to dial the selected one telephone number automatically over a second telephone line.